

REMARKS

Upon amendment, Claims 1-4, 6, 9-12, 14, 17 and 21-22 are pending in this application. Claims 21 and 22 stand withdrawn . Claims 16 and 19 have been canceled without prejudice. Claims 1-4, 14 and 21 have been amended to encompass the elected subject mater and to more clearly define the claimed subject matter. No new matter has been added by the amendments. Support for the amendments is found throughout the application and claims as originally filed.

Applicants respectfully reserve the right to pursue any non-elected, canceled or otherwise unclaimed subject matter in one or more continuation, continuation-in-part, or divisional applications.

Reconsideration and withdrawal of the objections to and the rejections of this application in view of the amendments and remarks herewith, is respectfully requested, as the application is in condition for allowance.

Rejections under 35 U.S.C. § 112, First Paragraph

Claims 1-4, 6, 9-12, 14 and 17 are rejected under 35 U.S.C. 112, First Paragraph, as failing to comply with the enablement requirement. In particular, the Office Action alleges that “the specification, while being enabling for a compound of formula (1-A) where R¹ is hydrogen or an alkyl group, R² is a cyano group; R⁵ is a methyl group; R^{6A} is a hydrogen and R⁷ is a trifluoromethyl or halogen group, does not reasonably provided enablement for any other

compounds or compositions not previously defined by the R variables.” Applicants respectfully disagree.

Without conceding the validity of the Examiner’s allegation, and solely for the purposes of advancing prosecution of the present application, Claim 1 has been amended to recite that: R¹ is hydrogen or -C₁-C₆-alkyl wherein C₁-C₆-alkyl can be further substituted with one to three identical or different radicals selected from the group consisting of halogen, hydroxy and C₁-C₄-alkoxy, R² is a cyano group; R⁵ is a C₁-C₄-alkyl, group; R^{6A} represents hydrogen, C₁-C₆-alkylcarbonyl, C₃-C₈-cycloalkylcarbonyl, wherein C₁-C₆-alkylcarbonyl can be substituted with one to three identical or different radicals selected from the group consisting of C₃-C₈-cycloalkyl, hydroxy, C₁-C₄-alkoxy, amino, mono- and di-C₁-C₄-alkylamino; and R⁷ is a represents halogen or C₁-C₆-alkyl, wherein C₁-C₆-alkyl can be further substituted with one to three identical or different radicals selected from the group consisting of halogen, hydroxy and C₁-C₄-alkoxy.

Applicants respectfully note that the Applicants and Examiner agree that the test of enablement is whether one reasonably skilled in the art could make or use the invention from the disclosures in the patent coupled with information known in the art without undue experimentation. Nevertheless, Applicants respectfully submit that whether or not the scope of a claim is broad is irrelevant to the assessment of the enablement of the claim. Indeed, Applicants submit that the implemetation of the test is the only question at issue in the present application.

Applicants respectfully submit that the pending claims are enabled because the specification "contains a teaching of the manner and process of making and using an invention in

terms which correspond in scope to those used in describing and defining the subject matter sought to be patented." *Id.*

While the Examiner has listed the variable definitions most commonly found in the examples, Applicants respectfully submit that one of ordinary skill in the art would readily be able to synthesize compounds in which R¹ is optionally substituted -C₁-C₆-alkyl and R⁷ is optionally substituted C₁-C₆-alkyl based on the teachings of the specification without undue experimentation.

Applicants further submit compounds in which R⁵ is a C₁-C₄-alkyl as compounds bearing a methyl substituent would likely react in a similar manner to compounds bearing ethyl, propyl and butyl substituents and would be expected to be synthesized through very similar methods. As such, one of ordinary skill in the art would be readily be able to make and use compounds bearing any lower alkyl substituent at R⁵ in light of the exemplary teaching of methyl in the examples presented in the specification.

Similarly, Applicants respectfully note that compounds in which R^{6A} represents optionally substituted C₁-C₆-alkylcarbonyl or C₃-C₈-cycloalkylcarbonyl, can be found in Examples 22-29 of the specification as originally filed. As such, one of ordinary skill in the art would be readily be able to make and use compounds bearing the claimed substituents at R⁶ in light of the examples presented in the specification.

Applicants respectfully assert that one of ordinary skill in the art based on the teachings of the specification can readily make and use all of the compounds encompassed by the instant

claims without undue experimentation. Applicants respectfully request that the rejections of the claims under 35 U.S.C. § 112, First Paragraph be withdrawn.

Double-Patenting Rejections

Claims 1-12, 14 and 17 are provisionally rejected on the grounds of nonstatutory obviousness-type double patenting over claims 1-12 and 14 of U.S. Patent Publication Application No. 2008/0021053 ("the '053 publication").

As it remains unknown what subject matter claimed and disclosed in the present application will be deemed allowable; any statement regarding these rejections made on Applicants' part is premature. Therefore, Applicants respectfully request that these rejections be held in abeyance until subject matter is deemed allowable in this application.

Applicants respectfully note that the present application is the national stage of PCT/EP03/09527 filed August 28, 2003 and that the '053 publication is the national stage of PCT/EP05/01487 filed February 15, 2005. Applicants respectfully remind the Examiner that if a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. M.P.E.P. §804.

Rejoinder of Method Claims

Claims 21 and 22 relate to methods of treating acute and chronic inflammatory, ischaemic or remodelling processes comprising administering a therapeutically effective amount of a compound of claim 1. As such, method of use claims 21 and 22 are commensurate in scope with the present compound claims. Since a search for the compounds of claim 1 will necessarily result in all uses of any such compounds, and as Applicants believe that claim 1 is presently in a condition for allowance, Applicants respectfully request rejoinder of method of use claims 21 and 22 in accordance with M.P.E.P. 821.04 and *In re Ochiai*, 71, F.3d 1565 (Fed. Cir. 1995).

CONCLUSION

In view of the amendments and remarks made herein, the application is believed to be in condition for allowance. Favorable reconsideration of the application and prompt issuance of a Notice of Allowance are respectfully requested. Please charge any required fee or credit any overpayment to Deposit Account No. 04-1105.

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Respectfully Submitted,

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